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Remarks

Claims 1-19 and 34-37 are pending in the present application. Claims 1, 13, and 17 have been amended, Claim 5 has been canceled, and new claims 38-39 have been added, leaving Claims 1-4, 6-19, and 34-39 for consideration upon entry of this amendment. Support for these amendments are found in the Specification and Claims as originally filed. No new matter is introduced by these amendments or new claims.

Claim 1 has been amended to include the limitation "a reinforcing layer selected from the group consisting of polyethylene terephthalate, polybutylene terephthalate, polyvinyl, polycarbonate, and polyetherimide" and the limitation "a polymer layer selected from the group consisting of polyvinylidene chloride, copolyester, and nylon." Support for this amendment can at least be found in Claim 5 as originally filed as well as in the Specification at page 5, lines 20-22 as originally filed.

Claim 13 has been amended to remove urethane from the Markush group of polymer layers.

Claim 17 has been amended to correct a typographical error in which the term "fluoride" has been amended to "chloride."

New claims 38-39 have been added to further claim the invention. Support for these claims can at least be found in the claims as originally filed as well as in the Specification at page 5, line 20 to page 6, line 4 as originally filed.

Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-19 and 34-37 stand rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. It is the Examiner's position that "Applicants have amended the claims to change all the terms 'anchoring layer' to 'polymer layer,' and fail to provide a support in the original specification." (Office Action, p. 2.) The Examiner further alleges that the amendment "clearly changes" the scope of the instant invention, and "appears to be new matter." (Office Action, p. 3.) The Examiner has required Applicants to

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provide clear support in the specification, or cancel the new matter. Applicants respectfully traverse the rejection.

In the previous submission, Applicants pointed out that specific antecedent basis for "polymer layer" could be found, for example, beginning at Page 4, lines 5-9. Additional antecedent basis can be found at page 2, last line, to page 3, lines 1-2; and the "Inventive Examples" set forth in Table 1. Applicants disagree that the amendment changes the scope of the invention, but regardless, one of ordinary skill in the art would understand from the specification as filed that the anchor layer is a polymer layer.

In order to determine whether an application meets the "written description" requirement with respect to later-filed claims, the application must simply indicate to those of ordinary skill in the art that as of the filing date the applicant had invented what is now claimed. *Id.*, at 1563, 19 U.S.P.Q.2d at 1116; see *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90, (C.C.P.A. 1976). What is now claimed is a composite film with a reinforcing layer and a polymer layer. Since this was disclosed at multiple locations in the specification as filed, the claims comply with the written description requirement.

Claims 1-4, 6-12, 17-19, 34 and 35 further stand rejected under 35 U.S.C. 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the claimed invention. It is the Examiner's position that Applicant's claims merely set forth characteristics desired in an article. Applicants respectfully disagree with the Examiner's contentions as to indefiniteness, but in the interests of advancing prosecution, have deleted the subject matter from the independent claims.

In view of the foregoing, Applicants respectfully request the reversal of the rejection of the claims under 35 U.S.C. § 112, first and second paragraphs.

Claim Rejections Under 36 U.S.C. § 103

Claims 1-19 and 34-37 stand rejected under U.S.C. 103(a) as allegedly unpatentable over Applicants' admission in view U.S. Patent No. 3,839,078 to Birchall et al. ("Birchall").

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With respect to Claims 1-3, 5, 6, 10, and 34, the Examiner maintains that Birchall teaches that it has been a common practice to coat the surface of a film substrate with one or more adhesion promoting layers which adhere to the film substrate and to which the superstrate (coating) readily adheres. (Office Action, p. 4, line 22, to p. 5, line 2.)

Applicants respectfully maintain that the Examiner has failed to meet the burden of establishing *prima facie* obviousness, because nothing in the Applicants' disclosure or Birchall provides any expectation of success with respect to (1) a polyurethane foam; (2) a reinforcing layer selected from the group consisting of polyethylene terephthalate, polybutylene terephthalate, polyvinyl, polycarbonate, and polyetherimide; and (3) a polymer layer selected from the group consisting of nylon, copolyester, and polyvinylidene chloride. The passage in Birchall relied upon by the Examiner at column (col. 22, lines 5-14) recites merely a "film substrate" and a "superstrate." The disclosure that it may have been "common practice" to use anchor layers between film substrates and superstrates does not amount to an expectation of success in using an anchor layer between a polyurethane foam and a particular film substrate, i.e., polyethylene terephthalate, polybutylene terephthalate, polyvinyl, polycarbonate, or polyetherimide film.

At best, this disclosure supports a finding of "obvious to try." However, a finding of "obvious to try" is not sufficient to support *prima facie* obviousness. The requirement for a determination of obviousness is that "both the suggestion *and the expectation of success* must be founded in the prior art, not in applicant's disclosure." *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) (*italics added*). An Examiner, then, cannot base a determination of obviousness on what the skilled person in the art might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do, based on the an expectation of success provided by the prior art.

For at least these reasons, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. Reconsideration and withdrawal of this rejection are respectfully requested.

It is further the Examiner's position that:

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[I]n the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify Applicants' admitted prior art by incorporating a commonly practiced anchor layer of isocyanate-ended polyurethane or vinylidene chloride-alkyl acrylate copolymer between the reinforcing PET film substrate and the polyurethane foam layer, motivated by the desire to obtain a strong adhesion between the polyurethane and PET layers, as a common practice to one skilled in the art of polyurethane and PET laminates. . . . Additionally, it should be noted that Birchall's isocyanate-ended polyurethane or vinylidene chloride-alkyl acrylate copolymer read on generic materials of the instantly claimed anchor layer of polyurethane and polyvinylidene chloride as claimed, and they are also inherently polymeric materials.

(9/30/05 Office Action, p. 5, lines 8-14, 19-23, 24, to p.6, lines 1-4.)

To advance prosecution, and reserving the right to rely on arguments previously submitted, Applicants have prepared and herewith submit comparative test data that demonstrate unexpected results. (See, Third Declaration of Brett Kilhermy, dated March 30, 2006, which accompanies this Amendment and Response.)

As set forth in the Third Declaration, a layer of polyurethane foam as described in the present application was cast onto five sample films to compare the effects on the separation of the foam layer from the PET reinforcing layer. The five sample films were as follows:

Sample #1 (Control) 2 mil PET reinforcing layer.

Sample #2 (Invention) 1.2 mil composite reinforcing film comprising a PET layer co-extruded with a low melting point copolyester polymer layer. The foam layer is cast onto the co-extruded polymer layer surface of the composite reinforcing film.

Sample #3 (Comparative) 1.2 mil composite reinforcing film comprising a PET layer co-extruded with a low melting point copolyester polymer layer. The foam layer is cast onto the PET layer surface of the composite reinforcing film.

Sample #4 (Comparative) 1.2 mil layer of a low crosslink density, isocyanate-terminated polyurethane ("polyurethane A") coated on a 2 mil PET reinforcing layer.

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Sample #5 (Comparative) 1.2 mil layer of a higher crosslink density, isocyanate-terminated polyurethane ("polyurethane B") coated on a 2 mil PET reinforcing layer.

The five samples were rubbed with a pencil eraser to determine if the foam layer would remain in contact with the PET reinforcing layer. Upon rubbing Experimental Sample # 2 with a pencil eraser, there was no delamination of the PET reinforcing layer and the foam layer did not separate from the PET reinforcing layer. In all the other above Samples, the foam layer readily separated from the PET reinforcing layer when rubbed with a pencil eraser. (Kilhenny Decl. dated March 30, 2006 at ¶ 6.) These results show that an anchor layer formed from an isocyanate-terminated polyurethane, as set forth in Birchall, would not prevent separation of the foam layer from the reinforcing layer. Therefore, prevention of separation of the foam from the reinforcing layer is due to the claimed polymer layer, rather than to anchor layers in general. The compressible foam tape as presently claimed therefore has unexpected, and unexpectedly superior results over the prior art.

Moreover, regarding the Claims 7 and 35, the Examiner states that the methods limitations "film is formed by coextrusion" have not been shown on the record to produce a patentably distinct article and therefore are *prima facie* obvious. Applicants traverse the rejection. As described above and in the Third Declaration of Brett Kilhenny, dated March 30, 2006, a composite reinforcing film formed by coextrusion provides unexpectedly superior results when compared to anchor layers generally disclosed in the prior art. Applicants respectfully submit that the unexpectedly superior results successfully rebut a *prima facie* case of obviousness, if it exists.

New Claims

New claims 38-39 have been added to further claim the invention. Support for this amendment can at least be found in the claims as originally filed as well as in the Specification at page 5, line 20 to page 6, line 4 as originally filed.

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Applicants believe that the present claim amendments and arguments fully address the outstanding rejections. Applicants therefore respectfully request reversal of the rejections and allowance of claims 1-4, 6-19, and 34-39.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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